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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,654	08/05/2003	Lalitha Vaidyanathan	1018-001US02	6366
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SHUMAKER & SIEFFERT, P. A. 1625 RADIO DRIVE SUITE 300 WOODBURY, MN 55125			EXAMINER ARAQUE JR, GERARDO	
			ART UNIT 3689	PAPER NUMBER
			NOTIFICATION DATE 11/26/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/634,654	Applicant(s) VAIDYANATHAN ET AL.	
	Examiner Gerardo Araque Jr.	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10/6/03; 12/1/03; 5/28/04; 12/8/04; 3/6/06.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of **claims 56 – 71** in the reply filed on **10/31/2008** is acknowledged.
2. **Claims 1 – 55 and 72 – 106** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on **10/31/08**.

Priority

3. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/504159, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. **Claims 58, 59, 60, and 61** do not benefit priority to application 09/504159 since there is no support or guidance for the claimed limitations of notifying an online marketplace, dispute types, and payment based on dispute types.

However, **claims 58, 59, 60, and 61** do benefit priority to application 60/469502 since they are fully supported by the specification.

Accordingly, **claims 58, 59, 60, and 61** are not entitled to the benefit of the prior application.

Specification

4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

5. **Claims 67 – 71** are objected to because of the following informalities: the Examiner asserts that the impact of the reputation rating based on a successful resolution of a dispute, completion of resolution of the dispute, failure of one of the one or more parties to complete resolution of the dispute, and failure of one of the one or more parties to accept the proposed resolution is nonfunctional descriptive subject matter the type of data being communicated and processed does not further limit the structural components of the claim and does not serve as a limitation to distinguish it over **Sloo**. In other words, the Examiner asserts that the system of **Sloo** is fully capable of transmitting data, processing data, and communicating with other system terminals/components. Consequently, it is further asserted that the type of data does not further limit the claim since it does not further limit any of the structural components.

Therefore, it is asserted that the impact of the reputation rating based on a successful resolution of a dispute, completion of resolution of the dispute, failure of one

Art Unit: 3689

of the one or more parties to complete resolution of the dispute, and failure of one of the one or more parties to accept the proposed resolution adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish it over the prior art. As claimed, the steps of the invention would be performed the same regardless of the type of data stored in the system.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 56 – 71** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. In regards to **claims 56 and 66**, the Examiner is uncertain how there can be a dispute with only one party involved. The Examiner asserts that in order to have a dispute there must be at least two or more party members involved.

9. In regards to **claim 57**, the Examiner is uncertain of how an automated process is performed if the dispute is sent to a specialist. In other words, if the dispute is sent to a specialist then the handing of the dispute is performed manually.

10. **Claim 59** recites the limitation "**the online marketplace**" in **line 2 of claim 59**. There is insufficient antecedent basis for this limitation in the claim.

11. **Claim 60** recites the limitation "**the online marketplace**" in **line 2 of claim 60**. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3689

12. **Claim 60** recites the limitation "**notification related to the method**" in **line 2 of claim 60** wherein the Examiner asserts that a notification was never provided in **claim 56** and, consequently, it is uncertain how and why the notification is to the online marketplace. There is insufficient antecedent basis for this limitation in the claim.

13. In regards to **claim 66 – 71**, the Examiner asserts that the applicant has claimed a system (apparatus), but has failed to show any of the structural components required for the system. The applicant has only disclosed a database (data structure) and an application server (software), which the Examiner asserts is not structure.

Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. **Claims 56 – 65** are rejected under 35 U.S.C. 101 because based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiner is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps,

or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, **Claims 56 – 65** are non-statutory since they may are not tied to another statutory class.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 56 – 71** are rejected under 35 U.S.C. 102(e) as being anticipated by **Sloo (US Patent 5,895,450)**.

2. In regards to **claim 56**, **Sloo** discloses a method comprising:

receiving case information at an online dispute information system, wherein the case information describes an online dispute involving one or more parties (**Col. 4 - 5 Lines 45 - 56; wherein the user registers a complaint with the required information and wherein the involved party members [see at least Col. 2 - 3 Lines 66 - 7] are included as well and where the information and resolution is conducted online**);

determining a proposed resolution of the dispute (**see at least Col. 7 Lines 28 – 41 wherein a resolution is determined**); and

issuing a communication to a reputation rating system of an online marketplace, wherein the communication directs the reputation rating system to update a reputation rating of at least one of the parties as a function of the resolution (**see at least Col. 2 Lines 7 – 20; Col. 8 Lines 50 – 10 wherein the information regarding the complaint, responses, and settlements are publicly accessible, i.e. online marketplace, and wherein ratings are provided regarding the party members and dispute resolution process**).

3. In regards to **claim 57**, **Sloo** discloses further comprising the step of automatically routing the dispute to one of an automated process and a dispute resolution specialist (**see at least Col. 7 Lines 28 – 49, Col. 8 Lines 5 – 49 wherein a user can select to have a Judge/Jury option and wherein the system will then automatically route the required information to the appropriate Judge/Jury [see also Automatic Decision Maker: Col. 4 Lines 23 – 30 and at least Col. 10 Lines 48 – 53]**).

4. In regards to **claim 58**, **Sloo** discloses wherein the automatically routing step is dependent upon a type of dispute (**Col. 9 – 10 Lines 57 – 6, Col. 10 – 11 Lines 48 – 36 wherein depending on the dispute the system will determine the appropriate setting or environment as well as the required artificial intelligence judging procedure for the dispute**).

5. In regards to **claim 59**, **Sloo** discloses further comprising the step of automatically notifying the online marketplace of the dispute resolution (**see at least Col. 2 Lines 7 – 20; Col. 8 Lines 50 – 10 wherein the information regarding the complaint, responses, and settlements are publicly accessible, i.e. online marketplace, see also Col. 5 Lines 3 – 11**).

6. In regards to **claim 60**, **Sloo** discloses further comprising the step of automatically notifying the online marketplace if at least one of the one or more parties fails to respond to a notification related to the method (**see at least Col. 2 Lines 7 – 20; Col. 8 Lines 50 – 10 wherein the information regarding the complaint, responses, and settlements are publicly accessible, i.e. online marketplace, see also Col. 5 Lines 3 – 11**).

7. In regards to **claim 61**, **Sloo** discloses further comprising the step of automatically collecting payment for the method, wherein the payment is dependent upon a type of the dispute (**Col. 8 Lines 25 – 28, Col. 11 Lines 58 – 62, Col. 12 Lines 15 – 25; wherein payment/compensation is provided to the judge/juror for the specific dispute and wherein payment/compensation is based upon the type of dispute; in other words, whether the dispute was a dispute that involved other judges, jurors, witness and wherein each of those individuals will require payment or whether the dispute was resolved using the automatic decision maker process and had no other party members that would have required payment**).

Art Unit: 3689

8. In regards to **claim 62**, **Sloo** discloses wherein the reputation rating is positively impacted as a result of a successful resolution of the dispute (**Col. 8 – 9 Lines 59 – 10 wherein high ratings can be provided based on a successful resolution**), and

issuing a communication comprises issuing a communication directing the reputation system to remove a negative feedback associated with the affected one of the parties (**Col. 8 – 9 Lines 59 – 10 wherein the system is notified of a successful resolution and previous lower ratings are overwritten with higher ratings**).

9. In regards to **claim 63**, **Sloo** discloses wherein the reputation rating is positively impacted by completion of resolution of the dispute (**Col. 8 – 9 Lines 59 – 10, Col. 11 Lines 38 – 53 wherein the rating is determined after the resolution has been completed, i.e. if the party member did not fail in complying with the judgment a positive rating is provided for the party member**).

10. In regards to **claim 64**, **Sloo** discloses wherein reputation rating is negatively impacted by a failure of one or more of the parties to complete resolution of the dispute (**Col. 11 – 12 Lines 38 – 15 wherein a lower rating is provided for a party member failing to comply with a judgment of the dispute**), and

issuing a communication comprises issuing a communication informing the reputation system of the failure of the one or more parties to complete resolution of the dispute (**Col. 11 – 12 Lines 38 – 15 wherein the system is notified of the parties failure to comply and is recorded into the system**).

11. In regards to **claim 65**, **Sloo** discloses wherein the reputation rating is negatively impacted by a failure of one of the one or more parties to accept the proposed

Art Unit: 3689

resolution (**Col. 11 – 12 Lines 38 – 15 wherein a lower rating is provided for a party member failing to comply with a judgment of the dispute**), and

issuing a communication comprises issuing a communication informing the reputation system of the failure of the one or more parties to accept the proposed resolution (**Col. 11 – 12 Lines 38 – 15 wherein the system is notified of the parties failure to comply and is recorded into the system**).

12. In regards to **claim 66**, **Sloo** discloses a system of resolving a dispute in one of a plurality of sectors of an online marketplace involving one or more parties, comprising:

a dispute database configured to store information about the dispute (**Col. 3 Lines 8 – 18 wherein a database is provided and configured to store data**); and

an application server operatively coupled to the dispute database adapted to determine a proposed resolution of the dispute and automatically communicate to a third party reputation rating system to modify a reputation of at least one of the parties as a function of the resolution (**Col. 3 Lines 8 – 18 wherein a server containing the application to handle the received data and capable of communicating to other terminals is provided**).

Regarding applicant's database configured to store information about a dispute and an application server communicating to a rating system to modify a reputation as a function of a resolution, the Examiner asserts this to be nonfunctional descriptive subject matter. That is to say, the type of data being communicated and processed does not further limit the structural components of the claim and does not serve as a limitation to distinguish it over **Sloo**. In other words, the Examiner asserts that the

Art Unit: 3689

system of **Sloo** is fully capable of transmitting data, processing data, and communicating with other system terminals/components. Consequently, it is further asserted that the type of data does not further limit the claim since it does not further limit any of the structural components.

Therefore, it is asserted that the database which is configured to store information about a dispute and an application server communicating to a rating system to modify a reputation as a function of a resolution adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish it over the prior art. As claimed, the steps of the invention would be performed the same regardless of the type of data stored in the system.

13. In regards to **claim 67**, **Sloo** discloses further comprising a web server operatively coupled to the application server capable of delivering the proposed resolution to a device for presentment to the one or more parties (**Col. 3 Lines 8 – 18 wherein the server is coupled to a network and capable of delivering data to other terminals; see rejection for claim 66 regarding nonfunctional descriptive subject matter**).

14. In regards to **claims 68 – 71**, the Examiner asserts that the impact of the reputation rating based on a successful resolution of a dispute, completion of resolution of the dispute, failure of one of the one or more parties to complete resolution of the dispute, and failure of one of the one or more parties to accept the proposed resolution is nonfunctional descriptive subject matter for the reasons stated above for **claim 66**.

That is to say, the type of data being communicated and processed does not further limit the structural components of the claim and does not serve as a limitation to distinguish it over **Sloo**. In other words, the Examiner asserts that the system of **Sloo** is fully capable of transmitting data, processing data, and communicating with other system terminals/components. Consequently, it is further asserted that the type of data does not further limit the claim since it does not further limit any of the structural components.

Therefore, it is asserted that the impact of the reputation rating based on a successful resolution of a dispute, completion of resolution of the dispute, failure of one of the one or more parties to complete resolution of the dispute, and failure of one of the one or more parties to accept the proposed resolution adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish it over the prior art. As claimed, the steps of the invention would be performed the same regardless of the type of data stored in the system.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure can be found in the PTO-892 Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

Art Unit: 3689

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. A./
Examiner, Art Unit 3689
11/20/08

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689